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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,406	02/23/2004	Franciscus J.T. Krabbenborg	62449A	1848

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THE DOW CHEMICAL COMPANY
INTELLECTUAL PROPERTY SECTION
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EXAMINER

ZEMEL, IRINA SOPJIA

ART UNIT PAPER NUMBER

1711

DATE MAILED: 05/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/784,406

Applicant(s)

KRABENBORG ET AL.

Examiner

Irina S. Zemel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-33 is/are pending in the application.
- 4a) Of the above claim(s) 28-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

Newly submitted claims 28-33 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The new claims 28-33 are directed to a alternative methods of use of the composition of claim 1 and relate o the invention of claims 1+ as such. The inventions claimed in the newly claimed methods are independent or distinct from the originally claimed and examined inventions. As seen from the newly submitted claims 28-33 and the original claims 19+ the composition claimed in the base claim 1 can be used in materially different methods, and, thus constitute distinct inventions.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 28-33 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 4-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 1299480 to Imperial Chemical Industries, Limited., (hereinafter "ICI") in combination with US Patent 3,700,758 to Johnson et al., (hereinafter "Johnson").

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The disclosure of the ICI and Johnson references is discussed in detail in the previous office action. As far as the newly added limitations to the properties of the composition, i.e., the ability to be melted at certain temperatures without being cured and be cured at certain recited temperatures, those limitations are considered to be inherent limitations of the compositions disclosed by ICI that contain substantially the same components.

As for the limitations of claims 20 and 24, the ICI reference expressly discloses amounts of tackifiers as being in ratio as low as to 2:5 with the base resin, which inherently places the amount of tackifier in the claimed range (even in the absence of any other component). The reference does not disclose specific amounts of plasticizers, such as PE wax, thus implying that any conventional amount may be used in the absence of showing of unexpected results that can be clearly attributed to the claimed amounts of plasticizers.

The limitations recited in claims 21 and 25 are met by the expressed disclosure of hydrocarbon resins as suitable tackifiers in lines 63 on page 1 of the ICI reference.

Thus, the claims are still considered to have been obvious over the combined teachings of ICI reference and the Johnson reference.

Response to Arguments

Applicant's arguments filed 3-15-2006 have been fully considered but they are not persuasive. The applicants first argue that the references (ICI and

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Johnson) do not disclose the composition as claim in the pending claims. The applicants in a paragraph bridging pages 9 and 10 of their response recite each and every limitation of the claims, however, do not specifically point out which limitation is not disclosed in the reference. The examiner discussed in detail in the previous office action (and with respect to the newly added limitations – in the instant action above), how each limitations is disclosed and met by the cited references. In the absence of discussion which specific limitations are not met and where specifically the Examiner erred by alleging that each and all of the limitations of the instant claims are met by the combined disclosure of the references, the Examiner maintains her position that each limitation is supported by the references.

The applicants further argue that the references do not teach the selection recited in the instant claims. While the references do not exemplify a specific combination as claimed in one illustrative example, the ICI reference clearly teaches or each of the component recited in the instant compositions making choices of each components (from the list of expressly listed choices) and their combinations equally obvious. The applicants further argue that there is significant difference between free flowing powders of ICI and the free flowable pellets of the instant invention, namely, heterogeneous powders and homogeneous particles. The examiner agrees that the mixture disclosed by ICI simply constituted mixed individual components, while, the claimed particles are melt processed and are more homogeneous compositions. However, this difference is an obvious common sense difference between mixed powders and

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melt processed powders. The applicants obtain their pellets by compounding the individual components and then melt processing them (see, for example, discussion in [0034-35] of the instant specification. Thus, once the powders of ICI are melt processed and palletized for any reason (such as to palletize or somehow otherwise compact powdered compositions to facilitate handling and transportation of the plastic in view of disclosure of Johnson, as discussed in the previous office action), the resulting pellets will be of the same homogeneous composition with similar properties.

Regarding the applicants arguments on top of page 11 that the claimed compositions are not known in the art since the specific selection is not taught, this argument is addressed above. Further, the applicants argue that palletizing is change in size ad shape and how the materials are able to function. In the absence of showing of unexpected results that can be attributed to the change in size/shape, this change is obvious as per discussions in the previous and the instant office action, since palletizing of free flowing powder is obvious for at least the reasons discussed in Johnson. As for the function of palletized materials, once again, it is reasonably believed that the properties of similar compositions processed in similar way would be similar. The applicants were invited to present evidence of unexpected results that can be attributed to any of the choice of materials/ change of shape, but chose not do so.

The applicants further argue that the compositions of ICI are melted at 140 C, thus not meeting the claims limitation that the composition is capable of being melted and extruded at 90 to 120 C. This argument lacks any logic. The

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composition of the ICI invention in the illustrative example is "passed into oven, and maintained at 140 C" (where it was. Most likely cured), which has absolutely nothing to do with the composition's ability to be melted at lower temperatures. The example illustrates one processing embodiment that has no connection by the way of illustration or otherwise to the claimed property. The claimed property is still believed to be an inherent property of the compositions disclosed by ICI in the absence of showing to the contrary (which, once again, are not presented on the record).

The applicants argue that the prima facie obviousness is not made out by the Office. The examiner believes otherwise. She specifically discussed the teachings of the references and reasons for the proposed combination and modification of references. The argument regarding "identical compositions" is already addressed above in detail. The compositions and choices of the components would have been obvious from the ICI reference. The applicants further argue that there is no disclosure in Johnson that shown forming pellets out of powders. While the reference may not expressly disclose forming pellets from powders, the reference expressly states that it is known to make hot melt compositions in the form of pellets, and that is the teaching that the examiner relied upon in the rejection. Compacting powders in pellets is notoriously known in the art (via melt extrusion or other techniques), and this knowledge is what the examiner further relied upon in the rejection. The applicants' arguments that Johnson does not teach specificities of the claimed compositions are simply irrelevant, since the examiner did not rely on this portion of the Johnson's

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teachings, but only relied on the background section in support of her position that palletizing hot melt compositions is text-book known in the art.

The arguments regarding tackifiers and plasticizers and their relative amounts are addressed in the rejection above. Again, teachings of Johnson relied upon in the rejection have nothing to do with specifically claimed components. The component limitations, including hydrocarbon resin tackifiers, are met by the primary ICI reference.

The arguments regarding limitations recited in claims 28-3 are moot in view of the claims not being under examination as drawn to non-elected inventions.

Applicant's arguments with respect to Enderle have been fully considered and are persuasive. The rejection of all claims over Enderle in combination with ICI and Johnson has been withdrawn.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

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calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

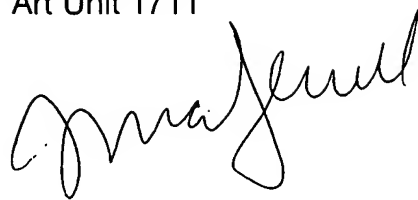
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Irina S. Zemel
Primary Examiner

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ISZ

A handwritten signature in black ink, appearing to read "M. J. Smith", is written over the printed text "Art Unit 1711".